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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,070	09/18/2003	Ross Vincent	118345/00021	7669
7590	01/05/2006			EXAMINER
Miller, Canfield, Paddock and Stone P.L.C. c/o Robert Kelley Roth Suite 2500 150 West Jefferson Ave Detroit, MI 48226			VANAMAN, FRANK BENNETT	
			ART UNIT	PAPER NUMBER
			3618	
			DATE MAILED: 01/05/2006	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/666,070	VINCENT, ROSS	
	<b>Examiner</b>	<b>Art Unit</b>	
	Frank Vanaman	3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 19 October 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,2,4,5 and 7-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1, 2, 4, 5, and 7-9 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

### **Status of Application**

1. Applicant's amendment, filed Oct. 19, 2005, has been entered in the application.

Claims 1, 2, 4, 5, and 7-9 are pending, claims 3, 6, and 10-14 having been canceled.

### **Claim Rejections - 35 USC § 103**

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 2, 4, 5, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lund et al. (US 2002/0101053) in view of Pohill et al. (US 6,588,781). Lund et al. teach a step assembly including a structural frame (30/48) having fore and aft edges (see figure 2), and at least one connector (34, 36, 24, 26) for connection to a vehicle frame, a step pad (22) made from a thermoplastic resin and comprising a step (62, 66) and fore and aft legs (90, 40, 42) corresponding to the edges of the structural frame, the step pad being secured to the frame, and forming a unitary construction, the pad having an underside cover (underside portion of 46, see also below 50/60 in figure 5) which co-operates with the pad top portion to further enclose the frame, the step pad having fore and aft walls (e.g., figure 4) which connect upper and lower pad surfaces and which extend past the fore and aft edges of the frame (30, 48), the walls being curved so as to wrap around the fore and aft walls of the frame.

The reference to Lund et al. is discussed above and fails to teach the provision of reinforcing ribs on the underside of the step pad, and on the legs of the step pad. The provision of reinforcing ribs on plastic constructions for the purpose of providing a strong and rigid structure whilst maintaining light weight and minimizing material usage, is very old and well known, and as such, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the underside of the step pad and the legs with reinforcing ribs for the purpose of providing a more rigid structure without requiring appreciably more material.

The reference to Lund et al. fails to teach the pad as having fore and aft walls on an underside of the pad, which are spaced to snugly receive the fore and aft walls of the frame (30/48). Pohill et al. teach a step pad (18, 20) which is provided at its under side (see figure 3) with fore and aft walls (48) which are spaced so as to receive mating fore

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and aft walls (e.g., 30) of a frame element (16/32). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide fore and aft walls on the underside of the pad taught by Lund et al. which are spaced to mate with the fore and aft walls of the frame, as taught by Pohill et al., for the purpose of ensuring that the pad and frame may be easily and quickly registered with one another when being assembled.

4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lund et al. in view of Pohill et al. as applied to claim 1 above, and further in view of Bernard (US 6,409,193). The references to Lund et al. and Pohill et al. are discussed above and fail to teach the plastic step pad as being injection molded around the frame. Bernard teaches that it is well known to construct plural elements of a step assembly for a motor vehicle, wherein one element may be molded to another by, for example, overmolding (see col. 11, lines 23-26). It would have been obvious to one of ordinary skill in the art at the time of the invention to connect the step pad and frame portions by an overmolding process as suggested by Bernard, for the purpose of providing a structurally sound, yet inexpensively connected final assembly. While Bernard fails to specifically teach injection molding, the injection molding process is very old and well known as an expeditious process for making formed plastic elements, and as such, it would have been obvious to one of ordinary skill in the art at the time of the invention to form the step pad by an injection molding process in order to ensure that it takes on a desired shape.

#### **Response to Comments**

5. Applicant's arguments, filed with the amendment, have been carefully considered. Applicant has argued that Lund et al. do not show the provision of reinforcing ribs on an underside of the step pad. The examiner agrees, however notes that the provision of reinforcing ribs on the underside of an element subjected to loading is very old and very well known, and certainly within the skill of the ordinary practitioner, as evidenced by the well known use of such ribs in other step pads, illustrated in Bernard ('979), Delgado and Schrempf, all of which provide evidence that such a feature is indeed old and well known. Applicant has argued that nothing in Pohill

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teaches the combination of elements (page 6 of the arguments) in the claim. As this remark can be interpreted as meaning "Pohill et al. fail to teach all elements of the claim", the examiner agrees, and notes that the reference to Pohill et al. is applied in combination with Lund et al. As this remark can be interpreted as "Pohill et al. fails to teach the motivation for making the combination", applicant may desire to consider that the teaching for making a combination does not necessarily come from the prior art, and there is no requirement that it must: rather, a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference (see *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)), with skill being presumed on the part of the artisan, rather than the lack thereof (see *In re Sovish* 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir. 1985)); further, references may be combined although none of them explicitly suggests combining one with the other (see *In re Nilssen* 7 USPQ2d 1500 (Fed. Cir. 1989)). It has long been the law that the motivation to combine need not be found in prior art references, but equally can be found "in the knowledge generally available to one of ordinary skill in the art." *In re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) (citing *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988)).

The motivation to combine can be found either in a prior art reference, or it can be implicit in the knowledge of one of ordinary skill in the art. See *In re Huston*, 308 F.3d 1267, 1280 (Fed. Cir. 2002); *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1472 (Fed. Cir. 1997).

Sources suggesting a combination may be: (1) the combined teachings of the prior art, (2) the knowledge of the ordinary practitioner and (3) the nature of the problem to be solved. "The test for implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed.Cir. 2000).

In *Richard Ruiz and Foundation Anchoring Systems, Inc. v. A.B. Chance Company*, No. 03-1333 (Fed. Cir. January 29, 2004), the court emphasized that an "express written teaching in the art" to combine references was not required [emphasis

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added]. Rather, motivation may come from "the nature of a problem to be solved, leading inventors to look to references relating to possible solutions to that problem."

Please further note the following from Section 2144 of the MPEP: "The rationale to modify or combine the prior art does not have to be expressly stated in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent...The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem...It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by Applicant." Also Chief Judge Nies writes in a concurring opinion, "While there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or the prior art specifically suggest making the combination...In sum, it is off the mark for litigants to argue, as many do, that an invention cannot be held to have been obvious unless a suggestion to combine prior art teachings is found in a specific reference". See *In re Oetiker* 977 F.2d 1443, 24 USPQ.2d 1443 (Fed.Cir.1992).

### Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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7. Any inquiry specifically concerning this communication or earlier communications from the examiner should be directed to F. Vanaman whose telephone number is 571-272-6701.

Any inquiries of a general nature or relating to the status of this application may be made through either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A response to this action should be mailed to:

Mail Stop \_\_\_\_\_  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450,

Or faxed to:

PTO Central Fax: 571-273-8300

F. VANAMAN  
Primary Examiner  
Art Unit 3618

